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08/895,386 07/16/97 HORI K HORI-101AX-C

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QM31/0409

EXAMINER

LEUBECKER, J
ART UNIT PAPER NUMBER

3732 33

DATE MAILED: 04/09/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on 7/16/97
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims:

- ☒ Claim(s) 50, 52, 56, 58, 61, 62, 67, 73, 76 and 79 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 50, 52, 56, 58, 61, 62, 67, 73, 76 and 79 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Due to the fact that existing claims contains subject matter that has been addressed in previous Office Actions (most of the subject matter that has been added to the independent claims throughout the prosecution originated from dependent claims that were previously rejected), the Examiner is relying on the discussion of certain prior art rejections made in previous Office Actions for brevity. Additional comments regarding Applicant's arguments with respect to these claims are addressed below.

3. Claims 50, 52 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (U.S. Pat. 4,488,039) in view of Kawahara (U.S. Pat. 3,819,267) for the reasons set forth in numbered paragraphs 6 and 7 of a previous Office Action, paper number 19.

4. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. in view of Kawahara as applied to claim 50 above, and further in view of Lia (U.S. Pat. 5,222,477) for the reasons set forth in numbered paragraph 10 of a previous Office Action, paper number 19.

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5. Claims 58, 61, 73 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. in view of Kawahara as applied to claim 52 above, and further in view of Wallace (U.S. Pat. 3,294,085) for the reasons set forth in numbered paragraph 9 of a previous Office Action, paper number 19.

6. Claims 62 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. in view of Kawahara and Wallace as applied to claims 58 and 73 above, respectively, and further in view of Richards (U.S. Pat. 3,091,235) for the reasons set forth in numbered paragraph 8 of a previous Office Action, paper number 19.

Response to Arguments

7. Applicant's arguments filed July 16, 1997 have been fully considered but they are not persuasive.

Regarding Applicant's arguments with respect to the Kawahara reference, Applicant points out that Kawahara does not relate to an electronic endoscope and particularly does not teach or suggest a photodetector movably mounted in the tube as if this fact disqualifies the reference from providing any relevant teaching concerning an endoscope. However, the Kawahara reference has been cited by the Examiner for teaching the use of an axially movable rod for controlling movement of an element at the distal end from the proximal end, a concept that in at

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least one response by Applicant was strenuously argued as being the patentable feature of the invention. A secondary reference relied upon for a certain teaching is not required to show every other element of the claimed invention. Otherwise, it could possibly anticipate the claimed invention, obviating the need for applying this reference as a secondary reference. This argument is therefore moot.

In addition, Applicant argues numerous points against bodily incorporating the “differential mechanism” of Kawahara and the embodiment incorporating a “string” into the device disclosed by Sato et al. Applicant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). As has been previously set forth, the Examiner takes the position that the prior art suggests to those of mere ordinary skill in this art, when faced with actuating mechanisms (i.e. motors of Sato et al.) disposed in the distal end¹, to control movable elements in the distal end of an endoscope using

¹ It must be noted that even though the Examiner is considering the motors disclosed by Sato et al. as being located in the distal end (for purposes of applying the prior art to the claimed invention and applying teachings from the art), Sato et al. never explicitly states that the motors are located in the distal end or are even required to be located in such. In fact Sato et al. show driver arrangements DR1 and DR2 in a conceptual way, leaving out specifics directed to

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actuating mechanisms in the proximal end (handle) with rods extending from the proximal end to the distal end. The Examiner has even set forth motivation to do so (note numbered paragraph 6 of paper number 19) that is consistent with conventional advantageous results normally sought in the endoscope art.

In the comments made by Applicant on page 13 of the remarks filed July 16, 1997, it appears that Applicant is suggesting that the Examiner has deemed certain modifications obvious without providing proper reasoning. Although Applicant fails to point out any of these issues specifically, the Examiner tends to believe Applicant is referring to features such as a "handle" and "gear mechanisms" that have been deemed inherent (or obvious from inherent suggestion) in light of the structure that is explicitly disclosed. If for some reason Applicant truly believes these features (e.g. a handle on an endoscope or a gear mechanism that converts rotory motion from the shaft of a motor to axial motion) are new and non-obvious, the Examiner would be happy to direct Applicant's attention to appropriate disclosures of such features. In any event, the Examiner wishes to point out that when making any kind of modification, the level of ordinary skill, with or without explicit teachings in the prior art, is still taken into consideration. It is proper to take into consideration not only the teachings of the prior art, but also the level of ordinary skill in the art. In re Luck, 476 F.2d 650, 177 USPQ 523 (CCPA 1973). Specifically, those of ordinary skill in the art are presumed to have some knowledge of the art apart from what

any number of conventional obvious structural arrangements that could provide the required function.

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is expressly disclosed in the references. In re Jacoby, 309 F.2d 513, 135 USPQ 317 (CCPA 1962).

It is noted by the Examiner that the non-obviousness of claims 52, 56, 58, 61, 62, 67 and 76 have been credited to the purported nonobviousness of claims 50 and 73, respectively. The non-obviousness of the limitations provided in these claims have not been discussed on there own merits.

Conclusion

8. This is a file wrapper continuation of applicant's earlier Application No. 08/581,307. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however,

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event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Leubecker whose telephone number is (703) 308-0951.

J. Leubecker
April 7, 1998



JOHN P. LEUBECKER
PATENT EXAMINER
GROUP 3300